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Remarks

Claims 19-44 are pending in the application. Claims 19-44 are subject to a restriction requirement, with claims 34-44 constructively elected by the Examiner.

Claims 34-36 and 39-40 have been amended. Claims 38 and 42 have been canceled. Support for the amendment can be found throughout the Specification, and in particular, on page 11, lines 17-20 and page 16, line 26 to page 17, line 12, and claims 38 and 42 as originally filed.

Response to Restriction Requirement

The Examiner has issued a restriction requirement to the claims of 19-33 (Group I) directed to a liquid plasticizing agent, and claims 34-44 (Group II) directed to a solid plasticizing agent. Based on original claim 4, the Examiner has constructively elected the claims of Group II (e.g., claims 34-44). The Group I claims have been withdrawn from consideration by the Examiner.

Applicants respectfully traverse the restriction requirement, and particularly, the constructive election of Group II claims for further prosecution. Prosecution of original claim 1 encompassed a genus of plasticizers (i.e., encompassing the species of liquid and solid). There was no restriction requirement issued in examination of claims 1-18. Thus, Applicants respectfully put forth that both liquid plasticizers and solid plasticizers received an action on the merits during prosecution before the filing of the RCE. Thus, constructive election was improper.

Upon request for continued examination, Applicants had submitted new claims 19-44 with claims to species of plasticizers (i.e., liquid and solid). Applicants acknowledge that the claims of a single species should have been elected with the presentation of claims 19-44 pursuant to MPEP 818.02(b). However, Applicants submit that in response to Applicants filing the RCE to species claims without election, a restriction requirement should have been issued to allow the Applicant to select a species for further prosecution pursuant to MPEP 818.03(e).

Applicants respectfully request reconsideration and withdrawal of the restriction requirement. Alternatively, Applicants request modification or waiver of the restriction requirement to allow Applicants to request the claims of Group I (claims 19-33) for further examination. See, e.g., MPEP 819.01.

In the event that the Examiner upholds the restriction requirement over Applicant's traverse, Applicants offer the following comments in response to the rejection of claims 34-44:

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Rejection Under 35 U.S.C. § 112, Second Paragraph

The Examiner rejected claims 34-35, and 40 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. Applicants have amended claims 35 and 40 to clarify that the plasticizer is applied in selective regions to the substrate. Support for the amendment can be found on page 16, lines 26-34 which discusses application of the plasticizer "before, during, or after deposition of the latent adhesive on the substrate." Based on the amendments, Applicants respectfully request that the Examiner withdraw the rejection under 35 U.S.C. § 112, second paragraph.

Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-18 are rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent No. 62-263270 to Fukumoto. Applicants have amended claim 34 and 39 to specify that the latent, over-tackified adhesive is selected from the group consisting of (meth)acrylic polymer, poly(alpha-olefin), and silicone. Based on the abstract translation provided by the Examiner, Fukumoto fails to disclose the materials claimed. Based on the amendment, applicants respectfully request that the rejections under 35 U.S.C. § 102(b) be withdrawn.

Conclusion

In view of the arguments offered herein, Applicants respectfully submit that the Examiner's grounds for objection and rejection are overcome and respectfully solicit reconsideration and withdrawal of the rejections to place the application in condition for allowance.

Respectfully submitted,

Nancy M. Lambert
Nancy M. Lambert
Registration No. 44,856
Attorney for Applicants

NML:jlh/56117US002 Amend to OA 3-15-04
Office of Intellectual Property Counsel
3M Innovative Properties Company
P.O. Box 33427
St. Paul, Minnesota 55133-3427
(651) 733-2180
Facsimile: (651) 736-3833

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